

USSN 09/620,248
Office Action dated: December 27, 2004
Response dated: February 28, 2005

REMARKS/ARGUMENTS

Amendments are made to claims 4, 22, 38-41 and 45. Minor amendments are made to claims 4 and 22, to make a claim element consistent with the term in the preamble for claim 4, and to add the missing conjunction "and" to claim 22. Claims 38-41 are amended to overcome a rejection as set out below.

In paragraph 3 of the Detailed Action the Examiner has rejected claims 38 to 41 and 45 under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Claim 38 has been amended and is now directed to a data signal. As discussed in the MPEP 2106 IV B 1(c), a signal claim directed to a practical application of electro magnetic energy is statutory regardless of its transitory nature (see *O'Reilly*, 56 U.S. at 114-119; *In Re Breslow*, 616 F.2b 516, 519-21 205 USPQ 221, 225-26 (CCPA 1980)). Claim 38 has also been amended to recite "wherein protection switching data is inserted within the path overhead, and transmitted via said data signal for providing switching instructions to a network element". The underlined portion identifies an added feature, and support for this added feature can be found, for example, on page 19, lines 3 to 18 of the present application.

Applicant submits that the signal of claim 38 is directed to a practical application in that while in the transmission medium the data signal provides transmission of the switching data which is "for providing switching instructions to a network element.". In other words, a signal carrying information that is being transported to a location for use at the location is directed to a practical application even if the information is used only at the location in that the signal provides a means for transporting the information for its intended use.

As such, claim 38 is directed to statutory subject matter under 35 U.S.C. 101.

Each one of claims 39 to 41 and 45 have also been amended to be directed to a data signal and depends from claim 38. As such, claims 39 to 41 and 45 are also directed to statutory subject matter under 35 U.S.C. 101.

The Examiner is respectfully requested to reconsider and withdraw the 35 U.S.C. 101 rejection of claims 38 to 41 and 45. If the examiner has any questions or concerns, please contact the undersigned (and please note the change of representation).

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In view of the foregoing, early favorable consideration of this application is earnestly solicited.

Respectfully submitted,

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